

Notice of Allowability

Application No.

08/581,992

Applicant(s)

PELLEGRINO ET AL.

Examiner

Hani Kazimi

Art Unit

3691

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address--

All claims being allowable, PROSECUTION ON THE MERITS IS (OR REMAINS) CLOSED in this application. If not included herewith (or previously mailed), a Notice of Allowance (PTOL-85) or other appropriate communication will be mailed in due course. **THIS NOTICE OF ALLOWABILITY IS NOT A GRANT OF PATENT RIGHTS.** This application is subject to withdrawal from issue at the initiative of the Office or upon petition by the applicant. See 37 CFR 1.313 and MPEP 1308.

1. ☒ This communication is responsive to 12/6/07.
2. ☒ The allowed claim(s) is/are 1-18.
3. ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some* c) ☐ None of the:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

* Certified copies not received: _____.

Applicant has THREE MONTHS FROM THE "MAILING DATE" of this communication to file a reply complying with the requirements noted below. Failure to timely comply will result in ABANDONMENT of this application.

THIS THREE-MONTH PERIOD IS NOT EXTENDABLE.

4. ☐ A SUBSTITUTE OATH OR DECLARATION must be submitted. Note the attached EXAMINER'S AMENDMENT or NOTICE OF INFORMAL PATENT APPLICATION (PTO-152) which gives reason(s) why the oath or declaration is deficient.
5. ☐ CORRECTED DRAWINGS (as "replacement sheets") must be submitted.
- (a) ☐ including changes required by the Notice of Draftsperson's Patent Drawing Review (PTO-948) attached
- 1) ☐ hereto or 2) ☐ to Paper No./Mail Date _____.
- (b) ☐ including changes required by the attached Examiner's Amendment / Comment or in the Office action of Paper No./Mail Date _____.
- Identifying indicia such as the application number (see 37 CFR 1.84(c)) should be written on the drawings in the front (not the back) of each sheet. Replacement sheet(s) should be labeled as such in the header according to 37 CFR 1.121(d).
6. ☐ DEPOSIT OF and/or INFORMATION about the deposit of BIOLOGICAL MATERIAL must be submitted. Note the attached Examiner's comment regarding REQUIREMENT FOR THE DEPOSIT OF BIOLOGICAL MATERIAL.

Attachment(s)

- | | |
|--|---|
| 1. <input type="checkbox"/> Notice of References Cited (PTO-892) | 5. <input type="checkbox"/> Notice of Informal Patent Application |
| 2. <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 6. <input type="checkbox"/> Interview Summary (PTO-413), Paper No./Mail Date _____ |
| 3. <input type="checkbox"/> Information Disclosure Statements (PTO/SB/08), Paper No./Mail Date _____ | 7. <input checked="" type="checkbox"/> Examiner's Amendment/Comment |
| 4. <input type="checkbox"/> Examiner's Comment Regarding Requirement for Deposit of Biological Material | 8. <input type="checkbox"/> Examiner's Statement of Reasons for Allowance |
| | 9. <input type="checkbox"/> Other _____ |

/Hani M. Kazimi/
Primary Examiner, Art Unit 3691

DETAILED ACTION

1. This communication is in response to Applicant's amendment filed on December 6, 2007. Claims 1-18 are pending in this application.

Examiner's Amendment

2. An examiner's amendment to the record appears below. Should the changes and/or additions be unacceptable to applicant, an amendment may be filed as provided by 37 CFR 1.312. To ensure consideration of such an amendment, it **MUST** be submitted no later than the payment of the issue fee.

Authorization for this examiner's amendment was given in a telephone interview with attorney Robert Fletcher on December 4, 2007. The application has been amended as follows:

AMENDMENTS TO THE CLAIMS:

This listing of claims will replace all prior versions and listings of claims in the application:

1. (Currently amended) A process for evaluating the strength of a specific intellectual property for purposes of commercializing it comprising the steps of:
 - a. interacting with a computer;

- b. entering data from one or more sources including from a complete set of pre-selected tasks and from a questionnaire; into said computer, said computer having been pre-programmed such that said data is organized by one or more predetermined risk factors grouped into categories consisting essentially of product data, manufacturing data, patent strength, patented commodity, patent/business relationship, general background, competitive environment, litigation history, insurance history and economic climate.
 - c. evaluating, using a computer, the data by comparing each risk factor and each category to a preset standard;
 - d. computing, using a computer, a score by transforming said data into a composite score which represents a relative degree of strength associated with any undertaking to commercialize said intellectual property.
2. (Original) The process of Claim 1 wherein entering of the data into the computer is done via telephone from a location other than the location having the computer.
3. (Previously presented) The process of Claim 1 wherein the predetermined risk factors are grouped into categories selected from the categorized of subjects comprising: Technical Orientation, Technical Review, Preliminary Assessment , Patent Study, Market Identification, and Analysis, Industry

Intelligence, Cost/Benefit Analysis, Marketing/Licensing Assessment and Licensing/Enforcement.

4. (Previously presented) The process of Claim 3 wherein transforming said data is achieved by calculating a category score for each category.
5. (Previously presented) The process of Claim 4 wherein each category score is weighted and combined with other category scores and used to modify a primary risk indicia to calculate said composite score.
6. (Original) The process of Claim 5 wherein the composite score is modified by a moral hazard factor to calculate a probable success factor.
7. (Previously presented) The process of Claim 6 wherein the probable success factor is multiplied in a post-computer step by projected recoveries to determine the net recovery from commercializing the intellectual property.
8. (Original) The process of Claim 7 wherein the intellectual property to be commercialized is a patent.
9. (Original) The process of Claim 7 wherein the intellectual property to be commercialized is a trademark.
10. (Original) The process of Claim 7 wherein the intellectual property to be commercialized is a copyright.
11. (Currently amended) A process for determining the probable success of a lawsuit comprising the steps of:
 - a. interacting with a pre-programmed computer;

- b. entering data from one or more sources including from a completed set of pre-selected tasks and from a questionnaire into said computer, said computer having been pre-programmed such that said data is organized by pre-determined categories consisting essentially of product data, manufacturing data, patent strength, patented commodity, patent/business relationship, general background, competitive environment, litigation history, insurance history and economic climate.
 - c. evaluating, using a computer, the data by comparing each category to a preset standard;
 - d. transforming, using a computer, said data into a composite score which represents a relative degree of strength associated with the lawsuit;
 - e. using the composite score to determine a probable success factor for undertaking the lawsuit.
12. (Original) The process of Claim 11 wherein the lawsuit is one involving intellectual property.
13. (Previously presented) The process of Claim 12 wherein the composite score is based upon an evaluation of one or more risk factors specific to the intellectual property upon which a suit is being brought.
14. (Previously presented) The process of Claim 12 wherein the composite score is a category score resulting from categorizing various risk factors into categories and determining a category score.

15. (Previously presented) The process of Claim 14 wherein the category score is used to modify a primary risk indicia in determining a composite score.
16. (Original) The process of Claim 15 wherein an adjustment for moral hazard is made to the composite score resulting in a probable success factor.
17. (Previously presented) The process of Claim 16 wherein the probable success factor is applied in a post-computer step to a projected recovery to determine the net recovery.
18. (Original) The process of Claim 14 wherein the determination of the category score is accomplished using at least one relative risk factor.
19. (Cancelled)

Any comments considered necessary by Applicant must be submitted no later than the payment of the issue fee, and to avoid processing delays, should preferably accompany the issue fee. Such submissions should be clearly labeled Comments on Statement of Reasons for allowance.

Conclusion

3. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Hani Kazimi whose telephone number is (571) 272-6745. The examiner can normally be reached Monday-Friday from 8:30 AM to 5:00 PM. If attempts to reach the examiner by telephone are unsuccessful, the examiner's

Application/Control Number:
08/581,992
Art Unit: 3691

Page 7

supervisor, Alexander Kalinowski can be reached on (571) 272-6771. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Hani M. Kazimi/

Primary Examiner, Art Unit 3691